

all other respects as far as the disclosure of all inventive details is concerned which are not explained in more details in the text. In the drawing:

Fig. 1 is a longitudinal sectional view taken through an inventive trocar sleeve; [and]

Fig. 2 shows a conventional trocar sleeve; and

Fig. 3 shows an embodiment of the trocar sleeve of Fig. 1.

*Please amend the first full paragraph on page 7 as follows*

A flange 4 is provided on the proximal end of the trocar sleeve 1, by which the trocar sleeve 1 bears against the outer wall of the abdominal wall for fixing the trocar by "clamping" the abdominal wall between the flange 4 and the longitudinal portions 11, 12. To this end the flange 4 may be adjustable in the longitudinal direction along the central portion 2, as shown in Figure 3.

In the Claims

Please amend claims 24 and 30 as follows:

**Version with Markings to Show Changes Made to Each Claim**

24. (Amended) Trocar sleeve for endoscopic applications, comprising:  
an elongate part having at least one passage for insertion of [an] a surgical instrument[ selected from the group consisting of an endoscope, scissors and the like],  
and

pivotal parts formed at a distal section of the elongate part, each having a blade end portion, the pivotal parts converging toward one another in a piercing position, wherein the blade end portions of the pivotal parts form a pointed tip which permits the cutting of [the] a body wall without an additional trocar mandrel.

30. (Amended) Trocar sleeve for endoscopic applications, comprising:  
an elongate part having at least one passage for insertion of [an] a surgical in-

strument[ selected from the group consisting of an endoscope, scissors and the like],  
and

pivotable parts formed at a distal section of the elongate part, each having a blade end portion, the pivotable parts converging toward one another in a piercing position, wherein the blade end portions of the pivotable parts form a pointed tip which permits the cutting of [the]a body wall without an additional trocar mandrel and wherein the distal section has a flange bearing against an outer side of the body wall.

### **Remarks**

The Examiner has rejected claims 24-31 under 35 USC §112. Applicant has amended claims 24 and 30 to more particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Specifically, the Examiner states that the phrase "or the like" in claim 24 and 30 is indefinite. Applicant has amended claim 24 and 30 removing the indefinite language and included the term "surgical" in line 2. Support for this amendment is found in the specification at page 1, lines 4-5. ("The present invention relates to a trocar sleeve for endoscopic applications in surgical and diagnostic procedures involving use of an endoscope, scissor and the like.") ; page 4, lines 13-14 and 23-24, as well as in claim 26, line 3.

Additionally, claim 24 has been amended to provide proper antecedent basis. In the Office Action, the Examiner states, "Claim 24 recites the limitation of 'surgery instrument' (line 3 of the claim)." There is no such language in claim 24. Applicant believes Examiner was referring to claim 26, which includes "the surgical instrument" in line 3. Proper antecedent basis for "the surgical instrument" is provided in amended Claim 24.

The Examiner has objected to the drawings under 37 CFR 1.83(a). Applicant has submitted Figure 3 to show the features of claim 31. No new matter has been entered. Applicant respectfully submits that Examiner's objection has been overcome as the drawings show every feature of the invention.

The Examiner has rejected claims 24-25 and 28-31 under 35 U.S.C. §102 (b) as anticipated by or, in the alternative, under 35 U.S.C 103(a) as obvious over U.S. Patent No. 5,354,302 to Ko.

Applicant asserts that Ko does not anticipate the present invention as it does not disclose, at least, the blade end portions converging to form a pointed tip that cuts the body wall without any additional instrument, as required by claim 24. In contrast, Ko specifically teaches a plurality of resilient wedge portions that form substantially "a blunt penetration end 18 (or tissue distending mechanism) that may be inserted through an opening in the body." Column 5, lines 35-43.

The Examiner alternatively argues that it would have been obvious to one skilled in the art to modify the blunt tip of Ko to a pointed tip as such a "minor modification" does not make any critical difference in the performance of the Ko device. Applicant respectfully disagrees, as the blunt conical end formed by the wedge sections serves the purpose of distending tissue to facilitate use of an additional instrument to cut or dissect tissue. (See column 5, lines 47-58.) If Ko was modified to have a pointed tip, it would not serve its disclosed purpose of distending tissue, while allowing another instrument to cut the tissue. Providing a pointed tip would not be an obvious modification to Ko for one skilled in the art, but rather a counterintuitive alteration that would render Ko inoperative.

Further, the present invention is patentable and non-obvious over Ko as the claimed device itself cuts the body wall, without need for an additional instrument as disclosed in Ko. In column 8, lines 37-40, Ko discloses that "an incisions is made into the

the skin sufficient to allow the outer sleeve 12 to be inserted through an opening caused by the incision." Thus, Ko teaches cutting or piercing the skin with a cutting instrument before a distal end of the device claimed therein may be introduced. Ko's instrument is suitable for penetration, i.e. passing through body tissue, but not for initially piercing, puncturing or cutting a body skin or body wall. Ko specifically teaches away from the present invention in which the pointed tip of the claimed device itself cuts the body wall without need for an additional instrument and without need for an incision to be made prior to introduction of the claimed device. The trocar sleeve of the present invention not only penetrates underlying tissues, but also permits initial puncturing of a body wall.

The Examiner has rejected claims 26-27 under 35 U.S.C 103(a) as unpatentable over Ko in view of U.S. Patent No. 5,320,627 to Sorenson *et al.*. Sorenson *et al.* do not disclose, teach or suggest the pivotable parts converging toward one another in a piercing position, wherein the blade end portions of the pivotable parts form the pointed tip of the present invention. In contrast, Sorensen *et al.* disclose tip members that do not themselves cut, but rather, form a protective cage around the cutting head. Column 7, lines 63-67.

Sorenson *et al.* teach away from the present invention in which the claimed device itself cuts the body wall. The Sorenson *et al.* device is to be inserted through an existing orifice or small incision. Column 1, lines 12-14, also column 4, lines 32-35. This same limitation of requiring a pre-existing incision is taught by Sorenson *et al.* in the operation of the first embodiment. Column 11, lines 36-40.

The Examiner cites Sorenson *et al.* for disclosure of spring-biased joints, and asserts that it would be obvious to provide such joints to the pivotable parts of Ko. Whether or not this is true, there is no disclosure in Sorenson *et al.* of the providing spring-biased joints in the pivotable parts which form a pointed tip that allows for cutting the body wall without use of an additional instrument. Therefore, Applicant asserts that claims 26-27 are independently nonobvious.

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February 26, 2003

The aforementioned remarks show claims 24-31 to be patentable over Ko and non-obvious over Ko alone and in view of Sorenson *et. al.*. It is respectfully submitted that all of the claims in the application are in order for allowance, and early notice to that effect is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'W. Whitmyer, Jr.', is written over a horizontal line.

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